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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/825,337
Filing Date: April 4, 2001
Appellant(s): Yagihashi et al.

MAILED

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GROUP 3600

Howard L. Bernstein
(Reg. No. 25,665)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed January 16, 2004 (Paper No. 11).

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(Assignee of record, *NEC Infrontia Corp.*)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(None.)

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(Claims 1-15 pending, rejected, and appealed.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(No amendment after final has been filed.)

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct:

- I. Whether or not claims 1-15 are unpatentable under 35 U.S.C. 103(a) for being obvious over *Tavor et al.* (US 6,070,149), in view of *Bezos et al.* (US 6,029,141).

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-15 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). Therefore, the claims will be addressed in the following three groups, as suggested by appellant:

Group I: Claims 1, 5, 9, and 14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). (Group requested by appellant.)

Group II: Claims 2-3, 6-7, 10-11, and 15 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). (Group requested by appellant.)

Group III: Claims 4, 8, and 12-13 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). (Group requested by appellant.)

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The prior art of record relied upon in the rejection of claims under appeal is as follows:

6,070,149	Tavor et al.	5/2000
6,029,141	Bezos et al.	2/2000

(10) *Grounds of Rejection*

I. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tavor et al. (US 6,070,149), in view of Bezos et al. (US 6,029,141).

Tavor et al. disclose a commercial sales method and system, comprising: registering in advance a specific-item catalog and a relevant-item catalog in a home page on the WWW (see, in particular, column 16, lines 17-37, and Figure 11); a purchaser viewing the specific-item and relevant-item catalogs on the home page via a network by means of a terminal, and sending a purchase request to a relevant-item seller selling the items relevant to the specific item designating one of the relevant items; the relevant-item seller delivering the purchased item to the purchaser in accordance with the purchase request; and, the relevant-item seller informing a settlement computer of sales data of the purchased item, wherein the specific-item catalog and the relevant-item catalog each comprise information about the item (item description) in addition to a link, but in the method and system of Tavor et al., one seller sells both the specific item and the relevant item, rather than one seller selling the specific item and a separate seller selling the relevant item.

However, Bezos et al. disclose a similar commercial sales method and system, and Bezos et al. indeed disclose two separate sellers working together, with the seller actually selling the product paying a commission to the other seller whose WWW home page generated the sale.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method and system of Tavor et al. so as to utilize two sellers working together rather than one unitary seller, in accordance with the teachings of Bezos et al., in order to generate increased sales by attracting a larger customer base by offering a greater number and selection of products for customers, particularly specialty/low-volume products, without having to incur additional inventory/carrying costs.

Regarding claims 2-3, 6-7, 10-11, and 15, the method and system of Tavor et al. keeps track of the purchase history of the purchaser (see, in particular, column 40, line 61 et seq.), but since there is no second seller, Tavor et al. disclose neither requesting permission from the purchaser to divulge the purchase history to the other seller, nor reducing the commission paid to the other seller with reference to the purchaser history data. However, asking permission to divulge a purchaser's history data and reducing the amount of commission paid for subsequent referrals after an initial referral are both well known, hence, obvious steps to follow in an online commercial sales method and system. Therefore, it would have been obvious to further modify the method and system of Tavor et al. so as to ask permission of the purchaser to divulge the purchase history of the purchaser to the other seller and pay the other seller less commission based on the purchase history, as is well known to do, in order to appease customer's privacy

concerns and compensate referral sales in accordance with their value (i.e. pay less for subsequent referrals because a customer is more likely to return to a site once he knows about the site and has done business there), since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 4, 8, and 12-13, the method and system of Tavor et al. includes sending the relevant-item seller a request for discounting the item designated for purchase and the relevant-item seller sending the purchaser an acceptance of the request, wherein the purchaser purchases the item for the discounted price after the purchaser receives the acceptance of the discount. See, in particular, column 14, lines 1-9, and Figure 7, block 98, the presentation to the seller by the purchaser of a coupon being considered “a request for a discount.”

(11) *Response to Argument*

I. Group I is Obvious over Tavor et al., in view of Bezos et al. (Amazon.com).

Regarding the argument that Tavor et al. fail to disclose all of the features recited by the claims of Group I, the argument is irrelevant, hence spurious, as the same shortcomings alleged by appellant were specifically pointed out in, and addressed by, the rejection. Therefore, the argument merely restates the facts admitted by the rejection, without pointing out any supposed or alleged error in the rejection, thus, should be disregarded.

Regarding the argument that Bezos et al. fail to remedy the deficiencies of Tavor et al. because Bezos et al. disclose only a single “vendor,” since the second entity they disclose is characterized by them as an “associate” rather than literally/explicitly as a second “vendor,” Bezos et al. indeed disclose a first vendor and a second vendor, since *during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow*¹, and since *the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory*². Inasmuch as an “associate” is commonly defined and accepted to mean *a person united with another or others in an act, an enterprise, or a business*³, and, as admitted by appellant, the first entity/vendor of Bezos et al. is indeed engaged in the act of selling, any “associate” of that vendor is then, by definition, united with the first entity/vendor in that act of selling. Therefore, the “associate” is a second entity engaged in the act of selling, hence, a second vendor.

Regarding the argument that the claims require that the products of at least two separate vendors be displayed on a single webpage, and that a sales commission be transferred from one vendor to the other vendor in consideration for the sale generated by the vendors on whose webpage the products are displayed, Tavor et al. disclose a product and a related product on a

¹ *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

² *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

³ *The American Heritage Dictionary of the English Language, Third Edition* (1992).

single webpage, albeit with only one vendor selling both products (the vendor whose webpage it is), thus, no one to whom to pay any commission. The teaching relied upon from the disclosure of Bezos et al. is merely the practice of separate entities/vendors working together to sell products, with the vendor that ultimately receives the sale paying a commission to the vendor that generates the sale, the sale being generated by one vendor using their webpage to list/advertise the other vendor's item for sale, the motivation to make such a modification to the method and system of Tavor et al. being to generate increased sales by attracting a larger customer base by offering a greater number and selection of products for customers, particularly specialty/low-volume products, without having to incur additional inventory/carrying costs. Other differences between the claimed invention and the disclosure of Bezos et al. are irrelevant, as the primary reference applied in the obviousness rejection, the disclosure of Tavor et al., discloses all other aspects of the claimed invention. The disclosure of Bezos et al. is only relied upon for specific teachings on the one point, as delineated hereinabove.

II. Group II is Obvious over Tavor et al., in view of Bezos et al. (Amazon.com).

Regarding the argument that the further elements of the invention recited by the dependent claims of Group II cannot be obvious over Tavor et al., in view of Bezos et al., as set forth in the rejection, because the independent claims of Group I, from which the dependent claims of Group II all depend, are not obvious over Tavor et al., in view of Bezos et al., the argument is irrelevant to consideration of Group II, thus, should be

disregarded. If the independent claims of Group I are ultimately deemed patentable over Tavor et al., in view of Bezos et al., then it logically and naturally follows that Group II (and Group III) will also be deemed patentable, without need of any further argument or consideration.

Regarding the arguments directed to the additional elements actually recited by the claims of Group II, that neither the disclosure of Tavor et al. nor the disclosure of Bezos et al. includes a first product vendor “requesting permission from a purchaser for the disclosure of purchase history data, and then, upon receiving permission, forwarding the purchase history data to a second product vendor,” the arguments are irrelevant, thus, should be disregarded, since the arguments, as non-responsive to the grounds of rejection, fail to point out any supposed or alleged error in the actual rejection. Tavor et al. indeed disclose keeping track of the purchase history of the purchaser (see, in particular, column 40, lines 61 et seq.), but since there is no second seller, Tavor et al. disclose neither requesting permission from the purchaser to divulge the purchase history to the other seller, nor reducing the commission paid to the other seller with reference to the purchaser history data. However, asking permission to divulge a purchaser’s history data and reducing the amount of commission paid for subsequent referrals after an initial referral are both well known, hence, obvious steps to follow in an online commercial sales method and system. Therefore, as explained in the rejection, it would have been obvious to further modify the method and system of Tavor et al. so as to ask permission of the purchaser to divulge the purchase history of the purchaser to the other seller and pay the

other seller less commission based on the purchase history, as is well known to do, in order to appease customer's privacy concerns and compensate referral sales in accordance with their value (i.e. pay less for subsequent referrals because a customer is more likely to return to a site once he knows about the site and has done business there), since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results. Furthermore, as applicant has failed to seasonably provide any traverse to the examiner's stated positions as to what is well known prior art, and, as any traverse would no longer be considered seasonable, the objects of the well known statements are therefore now deemed and considered henceforth to be admitted prior art.

III. Group III is Obvious over Tavor et al., in view of Bezos et al. (Amazon.com).

Regarding the argument that the further elements of the invention recited by the dependent claims of Group III cannot be obvious over Tavor et al., in view of Bezos et al., as set forth in the rejection, because the independent claims of Group I, from which the dependent claims of Group III all depend, are not obvious over Tavor et al., in view of Bezos et al., the argument is irrelevant to consideration of Group III, thus, should be disregarded. If the independent claims of Group I are ultimately deemed patentable over Tavor et al., in view of Bezos et al., then it logically and naturally follows that Group III will also be deemed patentable, without need of any further argument or consideration.

Regarding the arguments directed to the additional elements actually recited by the claims of Group III, that neither the disclosure of Tavor et al. nor the disclosure of Bezos et al. includes the provision of a discount being given, the method and system of Tavor et al. indeed includes sending the relevant-item seller a request for discounting the item designated for purchase and the relevant-item seller sending the purchaser an acceptance of the request, wherein the purchaser purchases the item for the discounted price after the purchaser receives the acceptance of the discount. See, in particular, column 14, lines 1-9, and Figure 7, block 98, the purchaser presenting a coupon to the seller being considered “a request for a discount.”

(12) Conclusion

Appellant has provided no arguments specifically responsive to the actual rejection of the claims of Group II or Group III, only Group I. The arguments with respect to Group II and Group III therefore fail to point out any supposed or alleged error in the actual rejections of these claims. Therefore, the arguments with respect to Group II and Group III should be deemed irrelevant and, as such, disregarded.


Moreover, as only arguments with respect to Group I should be considered, all of claims 1-15 should therefore stand or fall together as a single group for purposes of appeal.

For all of the reasons set forth hereinabove, it is believed that the rejection of claims 1-15 as unpatentable under 35 U.S.C. 103(a) for being obvious over Tavor et al., in view of Bezos et al., is proper and should be sustained.

For all of the above reasons, it is believed that the rejection should be sustained.


Respectfully submitted,


Date: March 31, 2004


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